

# Notice of Allowability

Application No.

09/762,629

Examiner

Russell Kallis

Applicant(s)

JORSBOE ET AL.

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendments filed 11/23/2004, 12/07/2004 and 12/21/2004.
2. ☒ The allowed claim(s) is/are 74-76,78 and 81-93 (renumbered 1-17).
3. ☒ The drawings filed on 09 February 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 12/22/2004.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

Art Unit: 1638

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/23/04 and 12/07/04 has been entered.

**EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Denise Kettelberger on 12/22/2004.

The application has been amended as follows:

In the claims:

In Claim 74, line 7, after "non-transformed" insert --plant-- and after "or" insert --plant--.

Claim 81 (currently amended) The process of claim 74, wherein said exposing comprises adding galactose to the [plant or plant tissue cells] plant cells or plant tissue in culture medium.

Claim 83 (currently amended) The process of claim 74, wherein said exposing comprises providing UDP-galactose to the plant cells or plant tissue.

In Claim 85, line 4, delete “: ”.

In Claim 86, line 4, delete “: ”.

In Claim 91, part b), line 2, change “non-transformed” to --nontransformed--, and after “nontransformed” insert --plant--, and before “tissue” insert --plant--.

In Claim 91, part c), line 2, after “nontransformed” insert --plant-- and before “tissue” insert --plant--.

In Claim 91, part c), line 3, after “nontransformed” insert --plant--.

Claim 92 (Currently Amended) A process for selecting transformed plant cells or plant tissue comprising:

- a) transforming plant cells or plant tissues that are sensitive to galactose toxicity with a transformation vector comprising a heterologous promoter operably linked to a polynucleotide molecule encoding UDP-glucose-dependent uridyl transferase;
- b) exposing the plant cells or plant tissue to galactose, wherein said galactose is toxic to non[-]transformed plant cells or plant tissue; and
- c) selecting transformed plant cells or plant tissue that are insensitive to galactose toxicity from a population of genetically nontransformed plant cells or plant tissue, wherein the galactose is toxic to the nontransformed plant cells.

Claim 93 (Currently Amended) A process for selecting transformed plant cells or plant tissue comprising:

- a) transforming plant cells[] *in vitro* or plant tissues[] *in vitro* that are sensitive to galactose toxicity with a transformation vector comprising a heterologous promoter operably linked to a polynucleotide molecule encoding UDP-glucose-dependent uridyl transferase;
- b) exposing the plant cells or plant tissue to galactose, wherein said galactose is toxic to non[-]transformed plant cells or plant tissue; and
- c) selecting transformed plant cells or plant tissue that are insensitive to galactose toxicity from a population of genetically nontransformed plant cells or plant tissue, wherein the galactose is toxic to the nontransformed plant cells.

The following is an examiner's statement of reasons for allowance: The rejections under 112 1<sup>st</sup> paragraph written description and enablement are overcome by Applicant's submission of amendments on 11/23/2004 and 12/21/2004 and in view of the Examiner's discovery of four polynucleotides encoding enzymes from divergent sources classified under 2.7.7.10 and in view of Applicant's presentation of publications directed towards discussion of the three dimensional structure of a 2.7.7.10 enzyme from *E. coli* and the structure of its nucleotide sugar binding site.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

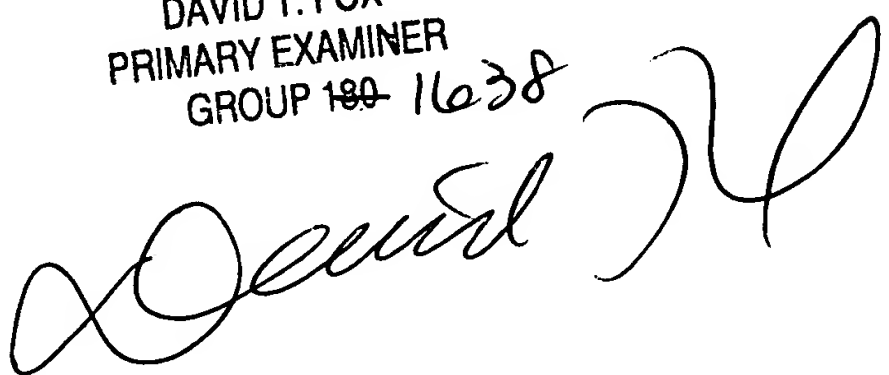
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Russell Kallis Ph.D.  
December 29, 2004

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

A handwritten signature in black ink, appearing to read "David T. Fox", is written over the printed name and title. The signature is stylized and cursive.